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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,102	12/05/2003	Uwe Scheim	WAS 0613 PUS / Wa 10265-S	3087
22045	7590	05/17/2006	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/729,102

Applicant(s)

SCHEIM ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/3/06 Amendment.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 21-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Applicants' amendment filed on March 3, 2006 was received. Claims 1-20 are deleted. Claims 21-39 are added. Now, Claims 21-39 are pending.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).
3. Applicant is advised that should Claim 25 be found allowable, Claims 29 and 32 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

4. Claims 23-24, 27-28, 35-36 and 38-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Examiner is unable to find the base for the limitations of the instant claims.

***Claim Rejections - 35 USC § 103***

5. Claims 21-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP167 (JP 63-083167) in view of Chung (US 4 495 331) and optionally further as evidenced by Freeman (Silicones, Published for the Plastics Institute, 1962, page 27) or Finger (US 6 254 811).

The claim rejections set forth in paragraphs 6-9 (Paper No. 121005) are applicable here. Furthermore, JP167 teaches the use of adhesion enhancer. (page 4, upper right column) JP167 further teaches that aminoalkyltrialkoxysilanes are typical adhesion enhancers. (page 2, lower right column) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the aminoalkyltrialkoxysilanes into JP167's composition. For the amount of the isocyanate deactivator in Claims 23, 27, 35 and 38, it is obvious to utilize the isocyanate compound in an amount of less than a stoichiometric amount based on all -OH group-containing compounds in the composition because each -OH group will generate one condensation by-product. Therefore, there is no

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need to add stoichiometrically excess amount of the isocyanate compound. For the amount of the isocyanate deactivator in Claims 24, 28, 36 and 39, the isocyanate compound will deactivate the condensation by-product as mentioned in paragraph 6 of Paper No. 121005. Thus, the amount of the isocyanate compound will depend on the amount of by-product produced. As such, the amount of the isocyanate compound is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the isocyanate compound in whatever amount through routine experimentation in order to efficiently deactivate the condensation by-products. Especially, Applicants do not show the criticality of the isocyanate-compound amount. See MPEP 2144.05 (II).

Although Applicants present extensive theoretical assumptions and assert that Chung's organic isocyanate compound is not suitable or not needed for JP167's composition, there are no evidences provided.

Applicants do point out that **very small quantities** of isocyanate added to the composition can unexpectedly improve the storage stability of the composition. (Remarks, page 11, 2<sup>nd</sup> paragraph) However, in view of Applicants' Examples (especially Example 1 vs. Comparative Example 1 or Example 3 vs. Comparative Example 2), the **unexpected results are not apparent**. Furthermore, the instant

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claims do not recite the amount **commensurate with** the aforementioned amount that is considered essential for the **unexpected results**.

*Allowable Subject Matter*

6. Claim 37 is allowed.

7. The following is an examiner's statement of reasons for allowance:

None of the above references, taken alone or in combination, teaches or fairly suggests the use of octylphosphonic acid.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp

May 12, 2006

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng  
Primary Examiner  
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